

Application No. 10/754,161
Amendment dated April 19, 2006
Reply to Office Action mailed January 20, 2006

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed January 20, 2006. New claims 22-34 are added. Claims 1-34 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. ALLOWED SUBJECT MATTER

The Examiner's allowance of claims 16-21 is appreciated. Applicants wish to thank the Examiner for the careful review and allowance of those claims.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. §102(b)

The Examiner rejects claims 1 and 2 under 35 U.S.C. § 102(b) as being clearly anticipated by *Ware* (United States Patent No. 3,508,835). The Examiner has not established that *Ware* teaches or suggests each and every element of the rejected claims. Therefore, Applicants respectfully traverse this rejection in view of the following remarks.

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (c) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as

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complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. Manual of Patent Examining Procedure ("MPEP") § 2131; *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

According to the Office Action on page 2, "it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, such as an optical device alignment mounting state does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations." With respect to this statement regarding claims 1 and 2 Applicant disagrees.

In citing to *Ex parte Masham*, 2 USPQ2d 1647 (1987) cited in section 2114 of the MPEP, it appears the Examiner has failed to give due consideration to the opening statement of that section which provides "For a discussion of case law which provides guidance in interpreting the functional portion of means-plus-function limitations see MPEP § 2181-2186." *Emphasis added*. Inasmuch as claims 1 and 2 clearly recite means-plus-functions limitations as contemplated by 35 U.S.C. § 112, paragraph 6, Applicant respectfully submits that the reliance of the Examiner on MPEP § 2114 is clearly misplaced.

Turning now to MPEP § 2182, that section states in part that "Both before and after *Donaldson*, the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim." MPEP § 2182. *Emphasis added*. In addition, the Court of Appeals for the Federal Circuit has stated, with respect to functional limitations of a means-plus-function claim, that "The limitations which must be met by an anticipatory reference are those set forth in each statement of function ... Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept." *RCA Corp. v. Applied Digital Data Sys.*, 730 F.2d 1440, 221 USPQ2d 385, 389 (Fed. Cir. 1984). *Emphasis added*. Finally, Applicant respectfully directs the attention of the Examiner to the guidelines for examining practice and procedure relating to limitations falling under 35 USC 112, sixth paragraph, set forth in 1162 Official Gazette, 59-61.

As the foregoing makes clear, the approach taken by the Examiner with respect to examination of the means-plus-function limitations of claims 1 and 2 is clearly contrary to the

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examination guidelines. As well, the approach taken by the Examiner also contravenes established Federal Circuit precedent. For at least these reasons, Applicant respectfully submits that the rejection of claims 1 and 2 should be withdrawn.

Moreover, Applicant notes that the Examiner has failed to establish that any of the cited references teaches the functional limitations of claims 1 and 2 in combination with the other respective limitations of those claims. For this reason, as well, Applicant submits that the rejection of claims 1 and 2 should be withdrawn.

In particular, regarding independent claim 1, the Examiner has not established that the *Ware* teaches the element, "means for engaging the at least one rotation paddle to selectively rotate the alignment carriage" [emphasis added] in combination with every other element of claim 11. MPEP 2181-2183. According to MPEP 2181 Section I, "[a] claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for" or "step for;"

(B) the "means for" or "step for" must be modified by functional language; and

(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function."

35 U.S.C. 112, sixth paragraph is invoked for the above element of claim 1 because the element uses the phrase "means for," which is modified by the functional language "engaging the at least one rotation paddle to selectively rotate the alignment carriage" and is not modified by sufficient structure for the claim function. The Applicant's disclosure provides structural support for such functional limitation, examples of which are illustrated in Figures 1-7 and the corresponding discussion.

After the Patent Office has identified the corresponding structure support in the Applicant's specification the Patent Office must point to equivalent corresponding structure in the Prior Art. "The Office Action should clearly communicate the findings, conclusions and reasons which support [the rejection]" (MPEP 2106 Section VII), which the Patent Office has failed to do here. In fact it appears that the Office Action ignores this element of claim 1 and the required analysis and instead provides nothing more than a vague reference to Figure 2. Thus, the Applicant is left to guess the position of the Examiner, which is against the rules of examination. As 37 CFR 1.104 sets forth:

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In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(Emphasis added). The Applicant requests that all mean-plus-function elements of the claims be addressed according to MPEP 2181-2183 and 35 U.S.C. 112 paragraph 6. Because every element of claim 1 has not been addressed as required for a *prima facie* case of anticipation, the Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Claim 2 depends from claim 1 and includes each and every element of claim 1. Thus, the remarks regarding claim 1 are applicable to claim 2 as well. Since the Examiner has not established that *Ware* teaches the stage being claimed in this application, Applicants respectfully request that the rejection of claims 1 and 2 under 35 U.S.C. § 102(b) be withdrawn.

The Examiner rejects claims 1-3, 5, 6, and 9-15 under 35 U.S.C. § 102(b) as being clearly anticipated by *Hayashi et al* (United States Patent No. 4,598,242). Because the Patent Office has not established that *Hayashi* teaches or suggests each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

Independent claim 1 includes the element, "means for engaging the at least one rotation paddle to selectively rotate the alignment carriage." (Emphasis added). Again, the Office Action has failed to address or perform the required analysis for this means-plus-function element. The Office Action fails to identify any corresponding structure for this element as required for a *prima facie* case of anticipation. Moreover, the Office Action has not shown that any of the elements 2, 5, or 8 perform the claimed functions of these claims. Thus, the rejection of claim 1-3, 5, 6, and 9-15 is improper and should be withdrawn.

Regarding the rejection of independent claim 9, the Office Action fails to address the element "at least one rotational control assembly that engages the at least one rotation paddle for selectively rotating the alignment carriage with respect to the base." Therefore a *prima facie* case of anticipation has not been set forth regarding claim 9.

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The Office Action has failed to address the elements of claims 2, 6, or 10-13. Therefore, a *prima facie* case of anticipation has not been set forth regarding claims 2, 6, or 10-13.

Claims 2-8 depend from claim 1 and claims 10-15 depend from claim 9. As such, the rejection of claims 2-8 and 10-15 should be withdrawn at least for the same reasons as claims 1 and 9.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 4, 7 and 8 under 35 U.S.C. § 103 as being unpatentable over *Hayashi*.

Claims 4, 7, and 8 depend from claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicant requests that the rejection of claims 4, 7, and 8 be withdrawn at least for the same reasons set forth above regarding claim 1.

The applicant notes, however, that the Examiner takes Official Notice on page 4 of the Office Action "that employing a screw for rotational paddle is old and well known in the art." It is well established that the mere fact that something is "well-known" cannot serve as a substitute for motivation. See *In re Spinnovle*, 160 USPQ 237, 243 (CCPA 1969) (emphasis added) ("a patentable invention, within the ambit of 35 U.S.C. §103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use."); also see *In re Warner*, 154 USPQ 173, 177 (CCPA 1967) which establishes that the question is never simply what is old; rather, the question is the obviousness of bringing the elements claimed in combination together. Accordingly, merely asserting that particular features of the claims are "old" or "well-known" in the art does nothing to establish a reason why the artisan would have been led to combine such features and, thus, does not inherently establish obviousness. Therefore, while the Examiner's Official Notice asserts that such components are known, this assertion does not, however, supply the required motivation for the proposed combination.

It also appears that the Examiner is relying on personal knowledge as a basis for rejecting claim 4 by stating that elements of the claims are well-known. In view of the foregoing, and

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pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claim 4 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claim 4.

Regarding claims 7 and 8, it appears that the Patent Office is trying to shift the burden for providing a prima facie case of obviousness. The Applicant notes that it is the initial burden of the PTO to demonstrate a prima facie case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added). If the Examiner is relying on Legal Precedent in *Graham v. Deere*, 383 U.S. 1 or *In re Leshin*, 125 USPQ 416, to support the rejection, the Examiner must show that the facts in the prior legal decision are sufficiently similar to those in this application. MPEP 2144.04. "[The Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 154, USPQ 173, 178 (CCPA 1967). Thus, the Office Action has not set forth a *prima facie* case of anticipation regarding claims 7 and 8. As such the Applicant requests that the rejection of claims 7 and 8 be withdrawn.

Moreover, the Applicant notes that the benefits of the elements of claims 7 and 8 are described throughout the specification.

III. NEW CLAIMS

New claims 22-24 have been added and are also allowable over *Ware* and *Hayashi*.

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CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 19 day of April, 2006.

Respectfully submitted,



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